OIPE IAP85
MAR 0 5 2007
PATENT & TRADEMARK OFFICE

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 14441RRUS01U

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on February 28, 2007

Signature: /Sherry Wolf McWhinnie/

Typed or printed name: Sherry Wolf McWhinnie

Application Number	Filed
10/034,001	December 26, 2001

First Named Inventor: Jerry Mizell

Art Unit	Examiner
2616	Bob A. Phunkulh

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 38,620.
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Kevin L. Smith/
Signature

Kevin L. Smith, Reg. No. 38620
Typed or printed name

972-772-8836
Telephone number

February 28, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

OIPE
MAR 0 5 2007
IAP85
PATENT & TRADEMARK OFFICE

DOCKET NO. No. 1444IRRUS01U
Customer No. 49,403

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Mizell et al.
Serial No.	10/034,001
Filed:	December 26, 2001
For:	Method & Apparatus for Network-Initiated Context Activation using Dynamic DNS Updates
Group No.:	2616
Examiner:	Bob A. Phunkulh

CERTIFICATE OF MAILING UNDER RULE 8

I hereby certify that this correspondence is being deposited in the United States Mail under 37 C.F.R. § 1.8 with sufficient First Class Postage and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 28, 2007.

By: _____
Sherry Wolf McWhinnie

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ARGUMENT ACCOMPANYING THE
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Submitted with the Pre-Appeal Brief Request for Review are these arguments and remarks, which are being filed with the filing of a notice of appeal, accompanied by the appropriate fee, and before the filing of an appeal brief.

A final office action had been mailed November 28, 2006, advising, in sum, that Claims 1 and 3-18 of patent application 10/034,001 stand rejected as being unpatentable under 35 USC § 103(a). The rejections stem generally from the hypothetical combination of Dorenbosch and Viola (see Final Office Action mailed November 28, 2006 [hereinafter Final Office Action], namely that:

(a) Claims 1, 3-8, and 16-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application No. 2002/10138622 A1 to Dorenbosch et al. ("Dorenbosch"), in view of Viola US Patent Application No. 2003/0058813 to Viola et al. ("Viola").

(b) Claims 9-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Viola in view of Dorenbosch.

Applicant respectfully submits that a *prima facie* basis for obviousness had not been established under the hypothetical combination of the cited references. Reconsideration of the Claims is respectfully requested.

1. Rejection under 35 U.S.C. § 103(a)

a. Dorenbosch *does not teach or suggest Applicant's claim limitations because the "external host or client" does not establish a session*

Dorenbosch relates to a "private network [that] is supplied with or allowed to use a small, relative to the population of units within the network, number of public addresses." (Dorenbosch ¶ 0004). The boundary network device of Dorenbosch deploys "network address translation *at the boundary* between the private and public networks [where] one of these public *addresses can be dynamically associated with a private address thus allowing an external host or client to establish a session with a unit within the private network.*" *Id.* (emphasis added). That is, the "external host or client" is not seeking to establish a session, only that it is allowed.

Further, Dorenbosch does not recite a method or apparatus with a dynamic host configuration protocol server. The Office Action notes the omission in Dorenbosch to this point. (*see* Office Action mailed June 8, 2006, at p. 3, ¶ 3).

b. Viola, *contrary to* Dorenbosch, *recites creating persistent IP addresses for a mobile node via a gateway*

The Office Action then sought to rely on Viola recites "[m]obile stations or handsets [that] may connect to the internet to activate certain applications through various servers. To access the internet, an Internet Protocol address is required." (Viola Col. 1:9-11). The "[m]obile station or handset 10 transmits a Packet Data Protocol (PDP) context activation 15 to get a dynamic Internet Protocol address from mobile network gateway (MNG) 20 (for GPRS services that is the Gateway GPRS Support Node or GGSN)." (Viola Col. 1:54-57). That is, allocation of a dynamic IP address, having a limited-time of validity, is by the mobile station, not the network.

Under Viola, its application server/client 40 does not seek to establish a session (*see* Viola Figures 2 and 5 (Activate PDP Context Request 51, 81, respectively). Instead, a "*handset 10* transmits a Packet Data Protocol (PDP) context activation 15 to get a dynamic Internet Protocol

address from mobile network gateway (MNG) 20 . . . ." (Viola Col. 1:54-57). That is, the *handset initiates* communication with the network. Further, the Office Action mailed June 8, 2006, noted that the application server/client 40 of Viola is not a push server (*see* Office Action mailed June 8, 2006, at p. 7).

Under Viola, "[as] time passes, the validity of the handset 10 IP address is reaching the end of its time [(that is, time-out)]. Since the [Mobile Node Gateway] 20 has been given the ability to store the handset name, IP address and expiration time, the MNG 20 will either renew the address time in its internal address pool or *submit a renew address request* to DHCP 50 via message 57. If MNG 20 requested address time renewal from DHCP server 50, server 50 will respond with an authorization for renewal and extension of time." (Viola Col. 2:47-55). That is, Viola seeks to provide persistent IP connections and/or PDP contexts via a mobile node gateway, which either attempts to rectify IP addresses internally, or seeks to lock-up a public IP address.

Dorenbosch teaches away from the approach of Viola because "[industry] standards specify or define IP connections or PDP contexts supported over wireless channels *to be non-persistent* in part due to the *perceived ephemeral nature of these connections and the perceived adverse impact on system capacity* that may occur with a more persistent connection or context." (Dorenbosch ¶ 0006).

Accordingly, Applicant respectfully submits that Dorenbosch and Viola each relate to disparate communication techniques, resulting in references that teach against each other.

c. Applicant's claimed invention is not directed towards mobile node initiation of a session, but instead towards "network-initiated context activation"

The deterrents of initiating PDP context activation with dynamic address assignments is the "[timing] out prior to the completion of the network initiated PDP context activation because of the all the steps that must be followed in a dynamic address environment." (*Id.* at p. 6, *ll.* 21-24 through p. 7, *ll.* 1-2). Applicant's invention provides for "reservation of dynamic IP addresses to enable a push server to initiate a PDP context as a part of providing push service without timing out." (Specification at p. 8, *ll.* 2-4).

For discussion, Applicant's Independent Claim 1 provides representative elements pertaining to its claimed invention. Independent Claim 1 recites a "method in a network for wireless communications for pushing data through a data packet network utilizing a dynamic addressing

scheme, comprising: *transmitting, from a push server* to a domain name server ("DNS"), a look up signal for a specified domain name; transmitting a *reservation signal from the DNS to a dynamic host configuration protocol ("DHCP") server to prompt the DHCP to reserve a dynamic IP address* that pertains to the specified domain name, wherein the specified domain name corresponds to a mobile terminal; receiving the reserved dynamic IP address at the push server; and activating a context, based upon the reserved dynamic IP address, through the data packet network." (emphasis added).

d. Applicant respectfully submits that motivation or suggestion for the hypothetical combination of Dorenbosch and Viola stem from its own disclosure

As the Federal Circuit has noted that "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The "motivation to combine" needs to show "reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Id.*

As noted above, Dorenbosch recites the non-feasibility of persistent IP addresses. Viola recites providing persistent IP addresses. It appears any "motivation or suggestion" would not stem from these disparate references.

The Final Office Action generally relies upon corollaries that appear to not mesh with the distinctions between Dorenbosch and Viola. The Final Office Action submitted that the push client 103 transmits to the Dorenbosch server 111, which "has a database cross referencing static . . . IP addresses 113 that fall within the private network's address space and corresponding user names 115." (Dorenbosch ¶ 0018). The Dorenbosch push client "operates to initiate the transfer of push data . . . to target devices." (Dorenbosch ¶ 0016). But it is, instead, the private network of Dorenbosch providing the access at the network boundary. (Dorenbosch ¶ 0017).

The Final Office Action submits that such corollaries are permissible in that "only knowledge which was within the level of ordinary skill at the time of the claimed invention was made was taken into account." (Final Office Action at p. 8 (*citing* In re McLaughlin, 443 F.2d 1392 (CCPA 1971)). Nevertheless, Applicant respectfully submits the rejection is contrary to *In re Rouffet*,

because corollaries were found, and then with the guidance of Applicant's specification (not with the disparate references of Dorenbosch and Viola) were hypothetically combined as a basis for rejection.

2. Conclusion

Accordingly, Applicant respectfully submits that there is no suggestion or motivation, and a lack of teaching or suggestion, for all of Applicant's claim limitations either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the network boundary device of Dorenbosch and the persistent IP-address device of Viola to achieve Applicant's claimed invention as set out in Claim 1 and Claims 3-8 that depend directly or indirectly therefrom, and Claim 16 and Claims 17 and 18 that depend directly or indirectly therefrom, or to modify Viola in view of Dorenbosch to achieve Applicant's claimed invention as set out in Claim 9 and Claims 10 and 11 that depend directly or indirectly therefrom, or as set out in Claim 12 and Claims 13-15 that depend therefrom. Applicant respectfully requests that the rejection to these claims be withdrawn.

As a result of the foregoing, the Applicant respectfully submits that Claim 1 and 3-18 are in condition for allowance, and respectfully requests allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ksmith@texaspatents.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126 (ref. 14441RRUS01U).

Respectfully submitted,

Date: February 28, 2007

/Kevin L. Smith/
Kevin L. Smith, Reg. No. 38,620
Attorney for Applicant

Garlick Harrison & Markison
P.O. Box 160727
Austin, Texas 78716-0727
(972) 772-8836/office
(972) 772-5033/facsimile